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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,866	11/06/2003	Martin Zimmermann	GS 0332 Div	7772
20676	7590	04/19/2005	EXAMINER	
ALFRED J MANGELS 4729 CORNELL ROAD CINCINNATI, OH 452412433			LEWIS, TISHA D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,866

Applicant(s)

ZIMMERMANN ET AL.

Examiner

TISHA D. LEWIS

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71 and 125-217 is/are pending in the application.
- 4a) Of the above claim(s) 71, 125-167, 180-211 and 214-217 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 168-174 and 176-179 is/are allowed.
- 6) ☒ Claim(s) 175, 212 and 213 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/995,401.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The following is a first action on the merits of application serial no. 10/701,866 filed on November 6, 2003.

Election/Restrictions

Claims 71, 125-167, 180-211 and 214-217 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 10, 2005.

Applicant's election with traverse of species V in the reply filed on February 10, 2005 is acknowledged. The traversal is on the ground(s) that the other claims are sufficiently related to the invention of the elected claims. This is not found persuasive because, although all the independent claims of the different species have the above limitations recited, the further limitations recited in each claim seem to suggest divergent subject matter that doesn't seem to be related as **one invention** for shift control of a transmission system.

Due to the plurality of different independent claims claiming different aspects of different species, it is unclear as to what applicant's invention is really pertaining to. If applicant still feels that all the claims should be examined in this application, then thorough clarification should be made as to how these different embodiments relate to each other and what the invention is according to these different embodiments.

The requirement is still deemed proper and is therefore made FINAL.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/995,401, filed on November 27, 2001.

Claim Objections

Claims 173, 179 and 212 are objected to because of the following informalities:

- In claim 173, line 2, between "engaged" and "the", a comma should be inserted.
- In claim 179, line 2, before "gear identity", "a" should be changed to --the--.
- In claim 212, line 6, before "transmission system", "a" should be changed to --the--.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 175, 212 and 213 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 175 recites the limitation "the gear end position" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 212 recites the limitation "the final value" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 212 recites the limitation "the clearance range" in line 10. There is insufficient antecedent basis for this limitation in the claim.

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Claim 212 recites the limitation "the clearance region" in lines 11 and 12, it is unclear as to if this is the same as the limitation "the clearance range", this should be clarified.

Claim 212 introduces the method of "decoding the gear identity" in line 14 and then recites "the decoding process" in line 15. The term "process" should be deleted since it was not introduced with the limitation of line 14.

Claim 213 recites the limitation "the gear end points" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.

In claim 213, line 4, the term "especially" is indefinite because it is unclear as to if the limitations following the term are part of the claimed invention.

Allowable Subject Matter

Claims 168-179 are allowed. The following is an examiner's statement of reasons for allowance: The prior art of record does not disclose or render obvious a motivation to provide for:

-(as to claim 168) a transmission system wherein a gear coding device encodes each engaged gear in which the identity of the encoded gear can be determined independently from an end value of an active position sensor in combination with ***all*** the remaining limitations of claim 168.

Claims 212 and 213 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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-(as to claim 212) a method for controlling a shift mechanism by encoding the identity of an engaged gear in accordance with a predetermined characteristic allocation value and then decoding the gear identity independent of a final value of a position sensor in combination with **all** the remaining limitations of claim 212.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 000-0000) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

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If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Tury ('769), Moreno ('009), Prakash et al ('317) and DE 19823050A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Tdl
April 14, 2005

[Signature]
TISHA LEWIS
PRIMARY EXAMINER
AU 3681 4/14/05